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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,604	12/17/2001	Shinichiro Hamada	217398US2RD	5932

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EXAMINER

SMITH, PETER J

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/015,604	Applicant(s) HAMADA ET AL.	
	Examiner Peter J Smith	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: application filed on 12/17/2001.
2. Claims 1-15 are pending in the case. Claims 1, 6, and 15 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Independent claim 11 and dependent claims 12-15 are directed toward “A computer program product for causing a computer function as a document editing apparatus”. As presently drafted, the claim reads on a computer program per se, which does not constitute statutory subject matter as prescribed under 35 USC §101. Applicant could easily render the claimed invention statutory by amending the preamble to recite “A computer program product stored on a computer readable medium”. The language in the preamble, “for causing a computer function as a document editing apparatus . . .” does not render the claimed invention statutory because it in effect constitutes intended use. See MPEP §2106:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

Therefore, the intended use language does not limit the claim, and cannot be given patentable weight or a cause for the preamble to be statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 6-9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al. (hereinafter "Miyagawa"), US 5,991,782 patented 11/23/1999.**

Regarding independent claims 1, 6, and 11, Miyagawa teaches extracting one or a plurality partial documents from the first documents according to locations of the first documents and ranges of the partial documents to be extracted, described by the specific markup language of the second document in col. 1 line 64 – col. 2 line 5, col. 2 lines 15-27, and col. 5 line 4 – col. 6 line 4. Miyagawa teaches that the documents may be coded for example in a structured document markup language such as SGML in col. 1 lines 33-38. Miyagawa teaches inserting the partial documents extracted by the extracting step into the second document according to insertion positions of the partial documents on the second document described by the specific markup language in the second document in col. 2 lines 36-64 and col. 6 line 6 – col. 7 line 9.

Miyagawa does not specifically teach that the locations of the first documents are on the Internet. Miyagawa does not specifically teach the use of HTML or XML, but does teach that the documents may be encoded in the precursor format, SGML in col. 1 lines 33-39. One of

ordinary skill in the art at the time of the invention would have had full knowledge of the use and implementation of HTML and XML documents referenced at locations on the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Miyagawa to have identified locations of the first documents on the Internet to have improved Miyagawa to have partialized and inserted portions of Internet documents to have created an aggregate second document. It would have been obvious and desirable to have combined Internet documents for the same motivations Miyagawa has to combine SGML documents in col. 1 lines 19-61.

Regarding dependent claims 2, 7, and 12, Miyagawa teaches wherein the extracting step and the inserting step use the second document which is described by using at least a tag for describing the locations of the first documents and the ranges of the partial documents to be extracted and specifying the insertion positions of the partial documents on the second document in col. 6 line 6 – col. 7 line 9. Miyagawa does not specifically teach that the locations of the first documents are on the Internet. Miyagawa does not specifically teach the use of HTML or XML, but does teach that the documents may be encoded in the precursor format, SGML in col. 1 lines 33-39. One of ordinary skill in the art at the time of the invention would have had full knowledge of the use and implementation of HTML and XML documents referenced at locations on the Internet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Miyagawa to have identified locations of the first documents on the Internet to have improved Miyagawa to have partialized and inserted portions of Internet documents to have created an aggregate second document. It would have been

obvious and desirable to have combined Internet documents for the same motivations Miyagawa has to combine SGML documents in col. 1 lines 19-61.

Regarding dependent claims 3, 8, and 13, Miyagawa teaches converting the document structure of the second document according to ranges for which the document structure of the second document is to be converted including the partial documents inserted by the inserting step and an identification information of a file describing a conversion rule for converting the document structure into a desired document structure, which are described by the specific markup language in the second document in col. 6 line 6 – col. 7 line 9.

Regarding dependent claims 4, 9, and 14, Miyagawa teaches wherein the converting step uses the second document which is described by using at least a tag for specifying the ranges for which the document structure of the second document is to be converted and describing the conversion rule in col. 6 line 6 – col. 7 line 9.

7. Claims 5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al. (hereinafter “Miyagawa”), US 5,991,782 patented 11/23/1999 as applied to claims 1, 6, and 11 above, and further in view of Lonnroth et al. (hereinafter “Lonnroth”), US 6,826,597 B1 provisional filed 3/17/1999.

Regarding dependent claims 5, 10, and 15, Miyagawa teaches wherein the extracting step uses a second document which is described in a structured document markup language such as SGML in col. 1 lines 33-39. Miyagawa does not teach wherein the second document is described in Extensible Markup Language (XML), and when the first documents are not described in XML, the extracting step extracts the partial documents from the first documents

Art Unit: 2176

after converting the first documents into a description format according to XML. Lonnroth does teach converting non-XML data into XML format in the col. 3 lines 14-31 and col. 10 line 63 – col. 11 line 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Miyagawa and Lonnroth to have created the claimed invention. It would have been obvious and desirable to have used XML to have described the second document as taught by Lonnroth in col. 3 lines 14-31. It would have been obvious and desirable to have used the conversion of Lonnroth so that the second document could have accessed Internet documents described in markup languages other than XML such as HTML as taught by Lonnroth in col. 1 lines 26-61.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Salisbury et al., US 6,397,231 B1 filed 8/31/1998 discloses creating a virtual document via combined documents or portions of documents. Robertson et al., US 6,507,410 B1 filed 9/8/1998 discloses non-linear document conversion. Lenk et al., US 6,366,923 B1 filed 3/23/1998 discloses clipping a portion of data from an Internet web site. Nehab et al., US 6,029,182 filed 10/4/1996 discloses generating a custom formatted hypertext document. Britton et al., US 6,535,896 B2 filed 1/29/1999 discloses tailoring web page content in markup language format. Tsimelzon, US 6,763,388 B1 filed 8/10/1999 discloses selecting and viewing portions of web pages.


Art Unit: 2176

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 571-272-4101. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
12/27/2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER